REQUEST FOR EXTENSION OF TIME

It is respectfully requested that the period for reply to the November 25, 2002 Office Action be extended one (1) month, *i.e.*, to up to and including March 25, 2003. A check for $55 for a small entity is enclosed. In the event any other fee is occasioned by this paper, the Commissioner is hereby authorized to charge the fee, or credit any overpayment in such fees, to Deposit Account No. 50-0320.

REMARKS

Reconsideration and withdrawal of the rejections to this application are respectfully requested in view of the following remarks which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-10 are pending. No new matter is added.

It is submitted that these claims are patentably distinct from the prior art, and that these claims are in full compliance with the requirements of 35 U.S.C. §112. The remarks made herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112; but rather the remarks are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. 35 U.S.C. §103 REJECTION

Claims 1-10 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,538,736 to Hoffmann et al. The rejection is traversed.

The Examiner is reminded of the case law; namely, that there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the

reference teachings. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (BOPAI 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine,* 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be found in the prior art, and not Applicant's disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

The instant invention is directed to a flat self-adhering plaster having a multi-layer construction and reduced cold flow, comprised of a layer of adhesive which attaches to skin having a core of adhesive which is rendered flowable by a plasticizing additive, and a ring of adhesive free of a plasticizing additive, wherein said ring has a reduced flowability to that of said core, and wherein said ring surrounds said core. Such an invention is neither taught nor suggested in Hoffmann.

More specifically, one of the features of the instant invention is that both the ring and core are applied simultaneously to the skin and removed simultaneously from the skin. For the Examiner's convenience, attached hereto is a diagram illustrating this feature. Also, the instantly claimed core has a flowable adhesive, whereas the surrounding ring has a less flowable adhesive. This configuration inhibits "cold flow." This configuration, however, also provides for sufficient adhesion of the core to the skin; sufficient protection of the skin; and a sufficient flux of active agents.

Contrary to the assertion of the Examiner, Hoffman does not teach, suggest, disclose or motivate a skilled artisan to practice the instantly claimed invention. The plaster in Hoffmann has two different reservoirs for the active ingredient, and each of the reservoirs adheres differently to human skin (*see* attached diagram, illustrating how the Hoffmann plaster is applied and removed from skin). The Hoffmann abstract recites "whereas at least one active substance reservoir part (12) is detachable from the skin, while leaving behind one or more active substance reservoir parts (13) on the skin. Indeed, according to column 3, lines 32-39, Hoffmann explains: "The active substance release surfaces can be juxtaposed, or one active substance reservoir part can completely surround one or more other active substance reservoir parts....Thus, e.g., one active substance reservoir part can circularly surround one or more other active substance reservoir parts."

Further, nowhere in Hoffmann is cold flow addressed. Applicants assert that one skilled in the art would not expect that a ring with reduced flowability would act as a barrier for a more flexible adhesive in a core, especially in view of the fact that the ring with the less flowable adhesive does not adhere to skin as strongly as the core adhesive.

Further, one of the advantages of the instant invention is that since the ring prevents the more flowable adhesive of the core from escaping, the flowability of the core adhesive can be increased. This would result in the core adhering with greater force to the skin, thereby facilitating the flux of the active ingredient. Nowhere in Hoffmann is such an advantage contemplated.

The Examiner is also reminded that the entire disclosure of a reference must be considered when presenting an obviousness rejection. In other words, picking and choosing portions from a disparate reference in order to formulate an obviousness rejection is

impermissible. Further, "obvious to try" is not the standard upon which an obviousness rejection should be based. *See In re Fine.* And as "obvious to try" would be the only standard that would lend the Section 103 rejection any viability, the rejection must fail as a matter of law. Therefore, applying the law to the instant facts, the rejection is fatally defective and should be removed.

Consequently, reconsideration and withdrawal of the Section 103(a) rejection is believed to be in order and such actions are respectfully requested.

CONCLUSION

By this submission, the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are all earnestly solicited.

Respectfully submitted,
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